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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/714,582
Filing Date: November 13, 2003
Appellant(s): CHIP BURTON et al.

James L. Shands
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/29/2009 appealing from the Office action mailed 04.01.2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-11 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haller et al. (U.S. Publication No. 2002/0013613).

1. As per claim 1, Haller teaches a method of compensating an operator of a defibrillator for expenses incurred as a result of use of the defibrillator for the benefit of another party to whom the operator has no duty to provide use of the defibrillator, the method comprising the steps of:
 - receiving a pre-determined monetary amount as a premium from the operator (**Haller: para. 0178**);
 - maintaining a contractual relationship with the operator for a period of time in exchange for the pre-determined monetary amount (**Haller: para. 0191**) the contractual relationship including a requirement to reimburse the operator for at least a portion of the expenses incurred as a result of using the defibrillator for the benefit of the other party (**Haller: para. 0178; para. 0188**);
 - determining, with a computing system, that the external defibrillator was used for the benefit of the other party during the period of time (**Haller: para. 0098; 0155-0156; 0171**); and

-in response to the determination, reimbursing the operator, in accordance with the contractual relationship and with the computing system, for the at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party (**Haller: para. 0188-0189**).

Applicant has amended claim 1, by adding the limitations external defibrillator and wherein the contractual relationship includes a requirement to reimburse the operator. As per this element, Haller does not explicitly teach wherein the contractual relationship includes a requirement to reimburse the operator. The limitation of the contractual relationship including a requirement to reimburse is a non-functional descriptive material. A clause within a contract could include a reimbursement clause, but the clause itself is a non-functional descriptive material. The invention is drawn to a contract including a clause to reimburse the operator. Any health related contract is representative of containing clauses related to reimbursement.

The reference fails to teach the method directed for an external defibrillator. However, the difference between the reference (prior art) and claims 12, 15, and 16 relates only to the intended use of the invention (i.e., to the types of defibrillator). A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim limitation.

Haller does not explicitly teach a method of insuring costs associated with an external defibrillator. However, Haller discloses a method of insuring costs that can be applied to a variety of products/goods, regardless of the intended field of use of the method. Haller teaches a

method of insuring costs associated with an internal defibrillator, though the method/system has utility in other applications. The method/system being adapted to an external defibrillator is irrelevant since the intended use does not change the overall functionality of the method. The intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill in the art to use the Haller method towards an external defibrillator because the Haller system is designed to be used towards any product/goods regardless of the intended use.

Examiner takes Official Notice that using an external defibrillators in response to another party undergoing a medical emergency is an old and well known usage in the healthcare art. It would have been obvious at the time of the invention to one of ordinary skill in the art to use the defibrillator of Haller for a purpose of assisting another party undergoing a medical emergency.

2. As per claim 2, the method of claim 1 is as described. Haller further teaches wherein the maintaining step comprises maintaining contractual relationships with a plurality of operators **(Haller: para. 0191)**.

3. As per claim 3, the method of claim 2 is as described. Haller further teaches further comprising allocating the expenses across the plurality of operators **(Haller: para. 0189)**. The examiner interprets that allocation of expenses were done due to reimbursements.

4. As per claim 4, the method of claim 1 is as described. Haller further teaches wherein the receiving the pre-determined monetary amount comprises receiving the pre-determined monetary

amount from the operator upon purchase of the defibrillator by the operator (**Haller: para. 0178; para. 0185**).

5. As per claim 5, the method of claim 4 is as described. Haller further teaches wherein receiving the pre-determined monetary amount comprises receiving the pre-determined monetary amount from the operator at a regular interval corresponding to the period of time (**Haller: para. 0178; para. 0188-0189**).

6. As per claim 6, the method of claim 5 is as described. Haller further teaches wherein the regular interval further corresponds to a period of contract for maintenance of the defibrillator (**Haller: para. 0189**).

7. As per claim 7, the method of claim 5 is as described. Haller further teaches wherein the period of time is annually (**Haller: para. 0191**).

8. As per claim 8, the method of claim 5 is as described. Haller further teaches wherein the period of time is monthly (**Haller: para. 0191**).

9. As per claim 9, the method of claim 4 is as described. Haller further teaches wherein receiving the pre-determined monetary amount comprises receiving the pre-determined monetary amount from the operator in conjunction with receipt of a lease payment for the defibrillator (**Haller: para. 0191**).

10. As per claim 10, the method of claim 1 is as described. Haller further teaches further comprising the step of requesting compensation for the reimbursement from the other party (**Haller: para. 0188-0189**).

11. As per claim 11, the method of claim 1 is as described. Haller further teaches wherein the period of time continues in perpetuity (**Haller: para. 0191**).

12. As per claim 14, the method of claim 12 is as described. Haller further teaches further comprising the step of seeking compensation for the reimbursement from an insurance carrier associated with the other party (**Haller: para. 0178; para. 0188**).

13. System claim 15 repeat the subject matter of claim 1 as a set of “means-plus-function” elements rather than a series of steps. As the underlying process has been shown to be fully disclosed by the teachings of Haller in the above rejection of claim 1, it is readily apparent that the Haller reference includes a system to perform the recited functions. As such, these limitations are rejected for the same reasons provided in the rejection of claim 1 and incorporated herein.

14. System claim 16 repeat the subject matter of claim 12 as a set of “means-plus-function” elements rather than a series of steps. As the underlying process has been shown to be fully disclosed by the teachings of Haller in the above rejection of claim 12, it is readily apparent that the Haller reference includes a system to perform the recited functions. As such, these limitations are rejected for the same reasons provided in the rejection of claim 12 and incorporated herein.

15. As per claim 17, the method of claim 1 is as described. Haller further teaches wherein the expense incurred as a result of the external defibrillator being used to benefit the other party include at least one of restoring the external defibrillator, refurbishing the external defibrillator, or replacing the external defibrillator with a different external defibrillator (**Haller: para. 0193**).

(10) Response to Argument

(1) Rejection of claim 1-11 and 14-17 under 35 U.S.C. §103(a) over Haller et al.

Appellant argues that Haller fails to disclose or suggest reimbursing the operator of defibrillator; Claim 1 recites “an operator” and “another party to whom the operator has no duty to provide use of the defibrillator.” Appellant further states that a patient is different from an operator or another party to whom the operator has no duty to provide use of the defibrillator. Examiner disagrees. Claim 1 recites “reimbursing the operator, in accordance with the contractual relationship and with the computing system, for at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party.” Haller teaches reimbursing for services rendered; furthermore teaching identification of the defibrillator to incur therapy from a remote system controlled by a provider who bills the insurance company. Therefore, the provider is reimbursed for the benefit of the other party.

Appellant argues that the external defibrillator is not given any patentable weight. In response to appellant's arguments, the recitation “external defibrillator” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Furthermore, the method steps involved has no relation to whether the defibrillator is an external or an internal; the steps recite reimbursement methods.

Appellant argues that Haller teaches reimbursing for “data” from the patient and not as a result of the defibrillator being used. Examiner disagrees. Haller teaches reimbursing for the use of services (i.e. use of defibrillator). Haller teaches government reimbursements for service charges incurred for using the defibrillator (i.e. a requirement to reimburse the operator for at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party).

Appellant argues that the Examiner’s characterization of “contractual relationship” as a non-functional descriptive material is an error. Examiner disagrees. Appellant provides a reasoning for what a “relationship” definition could not be, but does not provide how the specification describes a “relationship.” Examiner states that a contract is a non functional descriptive material, therefore, if there's a contractual relationship having a clause to reimburse, then that contractual relationship is the same as a contract having a clause and seen as a non-functional descriptive material. Haller further teaches providing a contractual relationship in the sense that the patient with the defibrillator has a contract with the insurance provider for a pre-determined monetary amount (i.e. premium) to use the services for however long the patient uses the defibrillator and then providing reimbursement options for costs incurred (Haller: para. 21; para. 177).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Sheetal R. Rangrej/

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